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09/918,312	07/30/2001	Jonathan Stern	2937.1000-008	9847

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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/918,312	Applicant(s) STERN ET AL.	
	Examiner Jeffrey R. Swearingen	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/19/2005 have been fully considered but they are not persuasive.
2. The rejection of the invention under 35 U.S.C. 101 is maintained. Applicant has admitted that the invention is illegal under the CAN-SPAM Act of 2003. See page 9, lines 5-7 of Applicant's response of 9/19/2005. Claims 1 and 6 may be directed toward email addresses, but those email messages are also *verified* as per claims 1 and 6. Claim 2 further denotes that said verification involves *testing* the email address. Applicant is invited to state how *verifying* or *testing* an email address is accomplished without sending an email message. Applicant further states that the invention is directed toward a *business email address*. Applicant is invited to clarify the difference between *business email* and "having a primary purpose of advertising or promoting a commercial product, service or website content as required by the CAN-SPAM Act of 2003". (Applicant response, 9/19/2005, page 9, lines 14-16)
3. Applicant reiterates the previous argument that the invention does not "assist in the origination of spam messages", but the verification provided for by Applicant is originating a spam message, since spam is unsolicited. Applicant has further argued on page 10 ways that a user can implement the invention that are legal under the CAN-SPAM Act according to Applicant. Such options are NOT stated anywhere in the specification or claims, and one of ordinary skill in the art would not know to implement the invention based upon the specification and claims using these options.
4. Applicant's amendments have overcome the rejection under 35 U.S.C. 102, but do not overcome the rejections put forth in this office action under 35 U.S.C. 103(a). Applicant's arguments are made towards the amendments herein presented.
5. Applicant argues the alternate language of *constructing and verifying potential email address* which is analogous to *generating email address* in the previously submitted claims.
6. Applicant's arguments concerning the Biliris reference are unclear. The Examiner has shown that the combination of Henrick and Miller discloses the *for whom e-mail address information is missing* clause

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of the claims, and is unsure of the reasoning that Applicant has applied in arguing this particular aspect of the Biliris reference.

7.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-23 are directed to an invention that sends unsolicited email to addresses it extrapolates from not readily available personal information that is extracted from websites via software agents. This device is non-statutory subject matter because it is in violation of the CAN-SPAM Act of 2003 (Controlling the Assault of Non-Solicited Pornography and Marketing Act) as enacted by Congress. Applicant is advised that the Federal Trade Commission is authorized to enforce the CAN-SPAM act, as is the Department of Justice. According to the requirements given by the FTC, CAN-SPAM covers "email whose primary purpose is advertising or promoting a commercial product or service, including content on a Web site". Claims 1-23 refer to business e-mail addresses and testing said business e-mail addresses. The Examiner contends that this device can be embodied as a device to search for information on individuals and send them non-solicited pornography and marketing electronic messages. The FTC further states that additional fines are provided for commercial emailers who "harvest" email addresses from Web sites or Web services that have published a notice prohibiting the transfer of email addresses for the purpose of sending email" and "generate email addresses using a 'dictionary attack' – combining names, letters, or numbers into multiple permutations". This is analogous to the claim language "automatically generating e-mail address of a subject person named in the database but for whom e-mail address information is missing from the database", "obtaining a working e-mail address to the respective organization the working e-mail address not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the

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respective organization; using the deduced information, constructing potential e-mail addresses for the subject person; and verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person", for example.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick et al. (U.S. Patent No. 6,377,936) in view of Miller (Online Search Secrets, 173-179).

12. Regarding **claim 1**, Henrick discloses providing a database storing information regarding people, the database including for each person at least name of the person and the name of respective employer for which the person is currently employed [Henrick discloses a customer mailing list. See Henrick, column 3, lines 53-54.]; and using digital processor means couple to the database, automatically constructing and verifying potential e-mail address of a subject person named in the database, the e-mail address being with respect to a respective organization named in the database for the subject person [Henrick discloses generating an e-mail message. Examiner considers constructing and verifying an e-mail address to be part of generating an e-mail message. See Henrick, column 3, line 54]. Henrick fails to disclose what to do if email address information is missing from the database. However, Miller discloses well known techniques for finding email address information on the web. Therefore it would be obvious to combine the tactics of Miller with the Henrick invention in order to allow more persons to be solicited by email, thus increasing revenue for the solicitor, as taught in the Henrick patent [Henrick, column 1, lines 10-36 referring to prior art and internet marketing]. By this rationale **claim 1** is rejected.

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13. Regarding claim 6, the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 6. By this rationale claim 6 is rejected.

14. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in further view of Mills (Australian Patent Abstract No. AU-A-53031/98).

15. Regarding claim 4, Henrick in view of Miller is applied as in claim 1. Henrick in view of Miller fails to disclose *using crawler means, automatically extracting information regarding people and / or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means.*

16. However, Mills discloses *using crawler means, automatically extracting information regarding people and / or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means.* [See Mills, page 8, lines 38-49].

17. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Mills with the teachings of Henrick in view of Miller for the purpose of improving the method of building a searchable database of contact information. [See Mills, page 6, lines 25-30]. Henrick provides motivation for the combination by stating that data mining is used to obtain information about network users. [See Henrick, column 5, lines 19-23] By this rationale claim 4 is rejected.

18. Regarding claim 9, the limitations of this claim are substantially the same as those in claim 4. Therefore the same rationale for rejecting claim 4 is used to reject claim 9. By this rationale claim 9 is rejected.

19. Claims 5 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Mills as applied to claim 4 and in view of Barroux (U.S. Patent No. 5,923,850).

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20. Regarding claim 5, Henrick in view of Miller in view of Mills are applied as in claim 4. Henrick in view of Miller in view of Mills fail to disclose *employing a multiplicity of crawlers under control of a distributor*.

21. However, Barroux discloses *employing a multiplicity of crawlers under control of a distributor*.

[Barroux discloses an administrative database and a task scheduler that schedules discovery tasks to be executed on the network. Examiner considers discovery tasks to include crawlers. Examiner considers task scheduler to be a distributor. See Barroux, column 3, lines 64-67. See Barroux, column 3, lines 41-52. See Barroux, column 4, lines 54-60.]

22. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Barroux with the teachings of Henrick in view of Miller in view of Mills for the purpose of tracking changes over time in information collected by network agents. [See Barroux, column 1, lines 50-56]. Henrick provides motivation for the combination by stating that data mining is used to obtain information about network users. [See Henrick, column 5, lines 19-23] Mills further provides motivation for the combination by stating that indexes [databases] are often created by use of web crawlers and that many relevant pages are missed. [See Mills, page 2, line 35 – page 3, line 19]. By this rationale claim 5 is rejected.

23. Regarding claim 10, the limitations of this claim are substantially the same as those in claim 5. Therefore the same rationale for rejecting claim 5 is used to reject claim 10. By this rationale claim 10 is rejected.

24. Claims 2-3 and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris et al. (U.S. Pub. No. 2001/0009017, hereafter referred to as Biliris.)

25. Regarding claim 2, Henrick in view of Miller is applied as in claim 1. Henrick in view of Miller fails to disclose *obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructing potential e-mail addresses for the subject person; and verifying each constructed potential e-mail address by testing*

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each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person.

26. However, Biliris discloses receiving a message from a sender system with a declarative address *[obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person]* and resolving the declarative address into messaging addresses by use of a database query on stored information *[deducing from the working e-mail address, format of e-mail addresses to the respective organization and using the deduced information, constructing potential e-mail addresses for the subject person]*. Biliris then transmits the messaging address(es) to the messaging server, which transmits the message to the addressed recipients *[verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person]*. [See Biliris, page 1, paragraphs 0009-0011. See Biliris, page 2, paragraph 0024.]

27. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Henrick in view of Miller and Biliris, for the purpose of sending messages to recipients without an explicitly enumerated mailing list. [See Biliris, page 1, paragraph 0009.] Henrick gives motivation for the combination of teachings by stating that users who might be interested in receiving information are reluctant to provide information to businesses. [See Henrick, column 1, lines 23-27.] By this rationale claim 2 is rejected.

28. Regarding claim 3, Henrick in view of Miller in view of Biliris are applied as in claim 2. Biliris further discloses using logical combinations of filtered directory information and mailing lists to specify a list of e-mail recipients *[using predefined common email address formats, see Biliris, page 3, paragraph 0033.]* By this rationale claim 3 is rejected.

29. Regarding claim 7, the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 7. By this rationale claim 7 is rejected.

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30. Regarding claim 8, the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 8. By this rationale claim 8 is rejected.

31. Claims 11, 13, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight (U.S. Patent No. 6,493,703) in view of Feridun et al. (U.S. Patent No. 6,336,139).

32. Regarding claim 11, Knight discloses a computer automated system for mining from a global computer network information on people and organizations comprising: a plurality of automated crawlers for traversing sites of a global computer network and retrieving pages that contain information of interest; a distributor coupled to the crawlers for controlling crawler processing; an extractor responsive to the crawler retrieved pages and extracting information about people and organizations therefrom; the extracted information being stored in a database; an integrator coupled to the database for resolving duplicate information and combining related information in the database; and a post-processor coupled to the database for analyzing contents of the database and generating missing information therefrom.

[Knight discloses searching a bulletin board system with software robots (plurality of automatic crawlers, column 5, lines 45-49), extracting information (column 5, lines 6-10), storing the information in a database (column 6, lines 40-59), and creates classifications of messages in logical groupings based on filters (combining related information and analyzing contents of the database and generating missing information, column 10, lines 1-53). Knight fails to disclose combining database records of information.

33. However, Feridun discloses aggregating data collected by a network agent [combining database records collected by a crawler, see Feridun, column 12, lines 37-40].

34. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight and Feridun for the purpose of detecting status changes in monitored objects (a person, see Feridun, column 2, lines 1-3.). Knight gives motivation for the combination by stating that not distinguishing between subject areas (changes in a person) results in frustration to the user. [See Knight, column 9, lines 45-54.] By this rationale claim 11 is rejected.

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35. Regarding claim 17, the limitations of this claim are substantially the same as those of claim 11. Therefore the rationale used to reject claim 11 is used to reject claim 17. By this rationale claim 17 is rejected.

36. Regarding claim 13, Knight and Feridun are applied as in claim 11. Knight further discloses a prioritization scheme utilizing frequency of occurrence of a subject category (statistical rarity of title and person's name, see Knight, column 6, line 60 – column 7, line 6). By this rationale claim 13 is rejected.

37. Regarding claim 19, the limitations of this claim are substantially the same as those in claim 11. Feridun deals with aggregating data between duplicate records. The name and organization name and title all fall into the general category of data in records, and therefore Examiner considers it to have little patentable weight when considering finding novelty in the claimed invention as compared to Feridun.

38. Regarding claim 20, the limitations of this claim are substantially the same as those in claim 13. Therefore the rationale used to reject claim 13 is used to reject claim 20. By this rationale claim 20 is rejected.

39. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Henrick.

40. Regarding claim 14, Knight is applied as in claim 11. Knight fails to disclose generating an e-mail address.

41. However, Henrick discloses generating an e-mail message. Examiner considers generating an e-mail address to be part of generating an e-mail message. See Henrick, column 3, line 54.

42. It would be obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight and Henrick for the purpose of sending e-mail by use of data mining. [See Henrick, column 1, lines 39-55.] Knight gives motivation for the combination by stating that information is gathered that is of interest to users, and that the gathered information can be transmitted to a user in the form of an electronic message. [See Knight, column 5, lines 45-67.] By this rationale claim 14 is rejected.

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43. Regarding claim 21, the limitations of this claim are substantially the same as those in claim 14. Therefore the rationale for rejecting claim 14 is used to reject claim 21. By this rationale claim 21 is rejected.

44. Claims 15-16, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight, Henrick in view of Biliris.

45. Regarding claim 15, Knight and Henrick are applied as in claim 14. Knight and Henrick fail to disclose *obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructing potential e-mail addresses for the subject person; and verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person.*

46. However, Biliris discloses receiving a message from a sender system with a declarative address [*obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person*] and resolving the declarative address into messaging addresses by use of a database query on stored information [*deducing from the working e-mail address, format of e-mail addresses to the respective organization and using the deduced information, constructing potential e-mail addresses for the subject person*]. Biliris then transmits the messaging address(es) to the messaging server, which transmits the message to the addressed recipients [*verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person*]. [See Biliris, page 1, paragraphs 0009-0011. See Biliris, page 2, paragraph 0024.]

47. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight, Henrick and Biliris, for the purpose of sending messages to recipients without an explicitly enumerated mailing list. [See Biliris, page 1, paragraph 0009.] Henrick gives motivation for the combination of teachings by stating that users who might be interested in

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receiving information are reluctant to provide information to businesses. [See Henrick, column 1, lines 23-27.] By this rationale claim 15 is rejected.

48. Regarding claim 16, Knight, Henrick in view of Miller and Biliris are applied as in claim 2. Biliris further discloses using logical combinations of filtered directory information and mailing lists to specify a list of e-mail recipients [*using predefined common email address formats*, see Biliris, page 3, paragraph 0033.] By this rationale claim 16 is rejected.

49. Regarding claim 22, the limitations of this claim are substantially the same as the limitations of claim 15. Therefore the rationale used to reject claim 15 is used to reject claim 22. By this rationale claim 22 is rejected.

50. Regarding claim 23, the limitations of this claim are substantially the same as the limitations of claim 16. Therefore the rationale used to reject claim 16 is used to reject claim 23. By this rationale claim 23 is rejected.

Conclusion

51. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

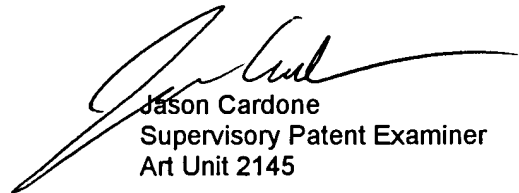
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145

JTS